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REMARKS

Claims 1, 5 and 7 have been amended by this paper. Claim 11 was previously cancelled, and Claim 2-4, 6, 8-10 and 12-14 remain unchanged by this amendment. Hence, by this paper, Claims 1-10 and 12-14 are presented for further examination.

Applicant expresses appreciation to the Examiner and his Supervisor for the time spent in a personal interview with counsel for Applicant on March 17, 2003. During that meeting, Claim 1 was discussed, along with references applied in the pending Final Office Action. The remarks herein encompass the arguments presented in the interview.

In an Office Action mailed November 4, 2002, the Examiner rejected Claims 1-4 and 7-12 under 35 U.S.C. § 103(a) as being unpatentable over Pond (U.S. Patent No. 4,864,616, hereinafter "Pond") in view of Computer Dictionary. Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pond in view of Computer Dictionary and further in view of Nashino, et al. (U.S. Patent No. 5,857,024, hereinafter "Nashino").

One embodiment of applicant's invention is directed to a system for providing security on a computer disk drive. In this embodiment, a computer includes an identification code that is associated with the computer. The identification code is stored in a *non-erasable memory*, such as ROM or PROM. Preferably, each identification code is substantially unique to that computer, and is stored in the computer prior to purchase by the user. In one embodiment, the computer automatically and transparently to the user encrypts data that is sent to a data storage medium using the identification code.

Pond is directed to a system of cryptographically labeling electronically stored data as part of a security system for personal computers. The labeling method utilizes a plurality of key streams which are related in some way to individual user and machine identifiers. Pond merely describes that "[d]uring installing of a PC security system, a machine identifier ("MID") may be assigned to the individual PC". See Pond, col. 3, lines 11-12. There is no teaching or suggestion in Pond that the machine identifier should be stored "in a non-erasable memory during manufacture of the personal computer" (See, e.g., Claim 1).

In an Advisory Action mailed February 21, 2003, the Examiner stated that "Pond does mention the MID is generated and stored at the time a security system is installed in the PC, which is not related to the location of the PC." See col. 7, lines 43-44. Applicant submits that the Examiner is correct in his reference to the language stating that the MID Keys are generated

and stored at the time a security system is installed in the PC. However, there is no statement in the specification suggesting that the stored information is not related to the location of the PC. In fact, the reference does teach that this MID Key can be related to the location of the PC. For example, the Examiner emphasized the above-identified language in Pond indicating that the "MID Keys are generated and stored at the time a security system is installed in the PC " (*emphasis added*) Pond is designed for use in computer networks. Accordingly, the reference discloses that the "overall security system, of which the present invention is a distinct element, may include circuitry that is installed in an expansion slot of the PC." (col. 2, lines 61-64 *emphasis added*.) If this circuitry were being "installed" during manufacture of the PC, there would be no need for it to be placed in an expansion slot. Furthermore, the information used for clear text identifiers comprises:

"(1) A Machine ID ("MID") comprising a data string uniquely identifying each personal computer (e.g. a location name);

(2) A Configuration ID ("CID") comprising a data string identifying the PC as part of a particular configuration in a PC network (e.g. a company name);

(3) A Primary ID ("PID") comprising a data string uniquely identifying an individual user logged-on to the PC (e.g. a user's name); and

(4) A Secondary ID ("SID") comprising a data string identifying a logical group of users of which the user logged-on to the PC is a member (e.g., a department name)." (col. 5, lines 22-34)

In view of the above, Applicant submits that the teachings of Pond, as identified above, clearly define the purpose of that system, which is to provide "protection for sensitive data stored in the PC as well as protection for data accessible through another PC in a network." (col. 2 lines 65-67.) This purpose is accomplished, as indicated in the quotes set forth above, by providing MIDs, CIDs, PIDs and SIDs for use in encryption, which comprise location names, company names, user's names, and department names, for example. This information would not reasonably be available for inclusion in a memory during the production of the PC. Since this information is "installed" in the PC at a later time, it would not be reasonable to store this information in a non-erasable memory. Such an action would require costly, special equipment and the use of programming techniques which are beyond the knowledge and skill level of the typical user of a PC.

Applicant respectfully submits that one of ordinary skill in the art would not consider using a non-erasable memory such as a ROM or a programmable ROM ("PROM") in a system such as that disclosed by Pond to store the MID. A ROM is constructed from hard-wired logic, encoded in the silicon itself, much the way that a processor is designed. It is designed to perform a specific function and cannot be changed. This is inflexible and so ROM is only used generally for a program that is static (not changing often) and it is usually mass-produced. During mass production of a non-erasable memory such as a ROM, it would be difficult if not impossible to know the destination location of the computer in which it is to reside. In addition, the PROM requires special hardware for programming. Applicant respectfully submits that given the above, it would not be generally possible to store the location name, company name, and the like during manufacture of the PC. Furthermore, it would be overly complicated to later include such information in a non-erasable memory such as a ROM or PROM which requires special manufacture for programming it or the use of special machinery.

In contrast to the Pond disclosure, Applicant's invention includes, inter alia, in a personal computer,

"a method of storing data on one or more magnetic optical data storage media in an encrypted form comprising:

storing an identification code in a non-erasable memory during manufacture of a personal computer wherein said identification code is defined at least in part by information associated with components of said personal computer" (*See Claim 1*).

There is neither any teaching nor suggestion in Pond of such a method. In fact, as noted above, Pond teaches away from the storage of the identification code in a non-erasable memory during manufacture. The use of a process such as that defined in Applicant's Claim 1 would effectively blunt the usefulness of the Pond system in accomplishing the purposes for which it was designed.

With respect to Claim 5, the Examiner refers to Nashino. However, Applicant submits that the Nashino reference is not used for encryption. Instead, the ROM of Nashino is used for reference purposes, in controlling access of an IC card that is requesting permission to access a computer system. In particular, the system provides an authentication method for an information processing apparatus, wherein the "IC card is employed to authenticate a mutual connection

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between the IC card and the information processing apparatus.” (col. 1, lines 13-15) Applicant submits that the Nashino system is not relevant to Applicant’s method as defined by claim 5, which includes:

“storing a hardware identifier in a non-erasable memory integrated circuit at the time of manufacture of the computer, wherein the hardware identifier is defined at least in part by information associated with components of said computer.” (see, e.g., Claim 5)

The mere fact the Nashino system includes a ROM does not make it relevant to Applicant’s claims, which are directed to encryption systems in a personal computer. Accordingly, Applicant submits that Nashino, by itself or in combination with other references does not teach or suggest the invention defined in Claim 5.

In the Advisory Action, the Examiner responded to Applicant’s arguments regarding the use of non-erasable memory by stating that

“[t]he Examiner asserts that the prior art as a whole which must suggest the desirability of modify the primary reference. In this case microsoft Dictionary suggests a motivation for storing information in a non-erasable memory. As the MID is obvious important information in Pond, et al. for copy protection system, it would have been obvious to store the MID in non-erasable memory.”

Applicant respectfully disagrees with the Examiner’s assertion, as set forth above. The dictionary definition submitted by the Examiner merely defines the terms “non-volatile memory” and “ROM”. In particular, Applicant notes that the definition of ROM indicates that

“To create a ROM chip, the designer supplies a semiconductor manufacturer with the instructions or data to be stored; the manufacturer then produces one or more chips containing those instructions or data.” (*emphasis added*)

Applicant submits that the mere definition of ROM, or non-volatile memory, does not provide any hint of a suggestion let alone an incentive to combine that device with a system such as that disclosed by Pond. In fact, as was indicated above, Pond teaches away from the use of non-erasable memory since it discloses generation and storage of the keys “at the time the

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security system is installed in the PC.” (col. 7, lines 44-45). This can occur once the clear text identifiers have been defined and once the circuitry for the security system “is installed in the expansion slot of the PC.” (col. 2, lines 67-64) Applicant submits that the use of non-erasable memory, programmed at the time of manufacture of the PC, could not reasonably accomplish the purpose or properly perform the function of Pond. For example, the definition set forth above suggests that the data to be stored is provided to the manufacturer. However the data to be stored in Pond includes location name, company name, user name and department name. Such information can be easily programmed into an erasable memory at the time the computer is placed into service, but would not reasonably be information given to a manufacturer of ROM for inclusion in a personal computer.

Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish *prima facie* obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the Pond system. Applicant respectfully submits that the Examiner has failed to provide a *prima facie* rejection and that independent Claims 1, 5, and 7 are in condition for allowance.

Furthermore, Appellant submits that it is improper to combine references where the references teach away from their combination.¹ The Court of Appeals for the Federal Circuit has stated that a reference teaches away if a “person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference.”² Additionally, to support a rejection under 35 U.S.C. § 103(a), the Examiner may not “pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.”³ Appellant submits that the Examiner in this case has failed to give due consideration to the disclosure of Pond that teaches away from its combination with ROM devices for storage of the machine identifiers.

¹ *See In re Grasselli*, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983).

² *In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994).

³ *In re Wesslau*, 147 U.S.P.Q. 391, 393 (CCPA 1965).

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In view of the above, Applicant submits that Independent Claims 1, 5 and 7 are neither taught, nor would they have been made obvious by the art of record taken independently or in combination. Furthermore, since Claims 2-4, 6, 8-10, and 12-14 each depend from one of Claims 1, 5 and 7, Applicant respectfully submits that these claims are also allowable for at least the reasons discussed above.

CONCLUSION

The Applicant has endeavored to address all of the concerns of the Examiner in view of the recent Office Action directed to the above-identified application. Accordingly, amendments to the claims, the reasons therefore and arguments in support of the patentability of the pending claims are presented above.

Any claim amendments which are not specifically discussed in the above remarks are made to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art.

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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